

**REMARKS/ARGUMENTS**

In response to the Office Action dated November 12, 2003, claims 8-15 are amended and claims 17-22 are added. Claims 1-22 are now active in this application. No new matter has been added.

The amendments to claims 8-15 are made to remove the "means plus function" phrases.

**OBJECTION TO THE DRAWINGS**

Fig. 1 of the drawings stand objected for using reference number 4 to designate both the copy machine and CPU of the copy machine. By this response, a new sheet of drawing of Fig. 1 is submitted to change the designation of the CPU of the copy machine to "41".

Fig. 1 stands objected also for not showing CPU 91 of the centralized management unit 90. However, CPU 91 is shown in Fig. 3, and need not be shown in Fig. 1. In this regard, it should be noted that the description on page 6, lines 20-21 is that "FIGS. 2 and 3 are block diagrams of the management system." There is no rule that requires each figure of the drawings to show every element described.

In view of the above, withdrawal of the objection to the drawings is respectfully solicited.

**REJECTION OF CLAIMS UNDER 35 U.S.C. § 103**

I. Claims 4, 5, 7-9 and 11-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tarr et al. (USPN 5,184,179) in view of Jarvis (USPN 5,918,010), for the reasons substantially of record.

The rejections are respectfully traversed.

(A)

On page 5 of the Official Action, under *Response to arguments*, the Examiner asserts, “In response to applicant’s argument that the Jarvis reference does not recognize the received packets are stale, particularly the Jarvis reference is not concerned with the delay of a data packet during transmission on the communication network, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Applicant sustains the combination of the Tarr and Jarvis reference[s] is based on upon improper hindsight reasoning, however, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant’s disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).”

Thus, the Examiner readily admits that Jarvis is concerned only with *preventing*, in a single system such as a linecard, *a received data packet from becoming stale between the time it is received by an interface of the linecard from the communications network* (such as an Internet) *and the time it is handled by the packet processor of the linecard, as well as preventing a data packet to be transmitted onto the communications network* (such as an Internet) *from becoming stale between the time the data packet is handled by the packet processor of the linecard and the time it is actually received by interface of the linecard for*

*transmission onto the communications network* (such as an Internet); i.e., preventing *contribution to staleness* of the data packet by the linecard itself.

In spite of these deficiencies, the Examiner (apparently) contends that a person of ordinary skill in the art, taking into account only knowledge which was within the level of ordinary skill at the time the invention was made, would take the teaching of Jarvis as to *not letting packet(s) become stale between the time the packet is received by an interface* of a single system (such as a linecard) *from a data communications network* (such as an Internet) *and the time the packet is actually handled by a packet processor* of the linecard, *as well as* the reverse, which is *the time between when a packet is handled by a packet processor* of the linecard *and the time the packet is actually received by the interface* of the linecard *for transmission onto the communications network* (such as an Internet), convert this to time-stamping a data packet with *the time that the interface* of the linecard *transmits the data packet onto the communications network* (such as an Internet), *then time stamping this transmitted data packet when the data packet is received by the addressed unit, and then using this time information for discarding stale data packets received via the communications network*, which the current record clearly evinces is only taught in the present application.

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Examiner. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). In rejecting a claim under 35 U.S.C. §103, the Examiner must provide a factual basis to support the obviousness conclusion. *In re Warner*, 379 f.2d 1011, 154, USPQ 173 (CCPA 1967); *In re Lunsford*, 357 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). Based upon the objective evidence of record, the Examiner is required to make the factual inquiries mandated by

*Graham v. John Deere Co.*, 86 S.Ct. 684, 383 U.S. 117, 148 USPQ 459, 469 (1966). The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or to combine applied references to arrive at the claimed invention. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

It should be recognized that the fact that the prior art could be modified so as to result in the combination defined by the claims at bar would not have made the modification obvious unless the prior art suggests the desirability of the modification. *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986).

Recognizing, after the fact, that a modification would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner, supra*.

As noted in the previous response, it is Applicant's disclosure which teaches time-stamping a data packet with *the time that the interface transmits the data packet onto the communications network* (such as an Internet), *then time stamping this transmitted data packet when the data packet is received by the addressed unit, and then using this time information for discarding stale data packets received via the communications network*. Thus, the only motivation of record for somehow modifying the teaching of Jarvis and to used this modified teaching in the system disclosed by Tarr et al. to arrive at the claimed inventions is found in Applicant's disclosure which, of course, may not properly be relied upon to support the ultimate legal conclusion of obviousness under 35 U.S.C. §103. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 227 1 USPQ2d 1593 (Fed. Cir. 1987).

Furthermore, reliance upon what the Examiner considers “knowledge which was within the level of ordinary skill at the time the invention was made” (what was known) to reject the claims is **NOT** objective evidence that the present claims as a whole, are obvious within the meaning of 35 U.S.C. § 103. Applicant stresses that what may be known in some general context does not necessarily render the claimed subject matter as a whole obvious within the meaning of 35 U.S.C. § 103.

In this regard, it is noted that the Examiner has not provided any evidence in the record as to what is “knowledge which was within the level of ordinary skill at the time the invention was made”, or that such knowledge includes “time-stamping a data packet with *the time that the interface transmits the data packet onto the communications network, then time stamping this transmitted data packet when the data packet is received by the addressed unit, and then using this time information for discarding stale data packets received via the communications network*”. Therefore, “knowledge which was within the level of ordinary skill at the time the invention was made”, and in particular that “a person of ordinary skill in the art *would know* that *time-stamping a data packet with the time that the interface transmits the data packet onto the communications network, then time stamping this transmitted data packet when the data packet is received by the addressed unit, and then using this time information can be used for discarding stale data packets received via the communications network*” lacks substantial evidence support.

The impropriety of merely asserting something to be “common knowledge” without supporting evidence in the record was established by the Federal Circuit in the case of *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001), overturning a decision of the Board of Patent Appeals and Interferences. Further supporting evidence that the Federal Circuit requires

evidence of record, not opinion by the Examiner (or Board), can be found in case of *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

Thus, as noted in the previous response, the Examiner has failed to establish a *prima facie* case of obviousness as the present rejection is an example of impermissible use of hindsight considerations (Applicant's disclosure) to combine the references to reject the claims.

**(B)**

Furthermore, in the invention recited in independent claims 15-14, the apparatus management devices permit transmission of the apparatus management data *to be sent from the centralized management device to the apparatus* and expiration date and time setting unit (of the centralized management device) sets expiration date and time information of the apparatus management data.

In contrast, Tarr et al. does NOT disclose the monitoring systems (which are similar to the apparatus management devices of claims 14 and 15) permitting such apparatus management data *to be sent from the centralized management device*. More precisely, there is nothing disclosed in Tarr et al. regarding information being sent from the billing computer to the copier, and the monitoring systems only receive the signal from the copier and do NOT transmit any information to the copier.

In this aspect, on page 2 of the Official Action, the Examiner maintains that Tarr et al. describe at column 6, lines 39-68 "permitting transmission of the apparatus management data to the apparatus connected to said apparatus management unit on condition based on the current time obtained from an internal clock". However, in fact, it is described in Tarr et al. that the monitoring system (monitoring CPU 24) sends the information (that is the total count or is the

maintenance signal) to the billing computer or to the service center. Therefore, the monitoring system in Tarr et al. does **NOT** transmit any information from the billing computer or the service center *to the copier*.

Therefore, even if one ordinary skilled in the art would recognize that Jarvis teaches sending out a time-stamped data packets having expiring times placed on them with a clock for providing the time-stamped information, the invention recited in claims 14 and 156 does not result as there would not be a centralized management device that comprises:

- an expiration date and time setting unit for setting expiration date and time information of the apparatus management data; and
- a communication network for sending out a packet being addressed to a specified apparatus management device and including the expiration date and time information to the communication network...

Thus, claims 14 and 15 are patentable over Tarr et al. and Jarvis, considered alone or in combination.

(C)

Regarding the other independent claims 1, 8, 16 and 18, these claims are substantially the same as claims 15-14 in the above aspects. Therefore claims 1, 8, 16 and 18 are patentable over Tarr et al. and Jarvis also.

(D)

Accordingly, withdrawal of the rejection of claims 4, 5, 7-9 and 11-15 under 35 U.S.C. § 103, as well as the allowance of claims 4, 5, 7-9 and 11-15, are respectfully solicited.

**II.** Claims 1, 6, 10 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tarr et al. et al. in view of Jarvis, and further in view of Frantz (USPN 6,003,070).

The rejections are respectfully traversed. Independent claims 1 and 16 are patentable over Tarr et al. and Jarvis for the reasons stated above in I. As claim 6 depends from claim 4 and claim 10 depends from claim 8, they are patentable over Tarr et al. and Jarvis also, even when considered in view of Frantz.

**III.** New claims 17-22 are submitted. Claims 17 and 18 depend from claim 18. New independent claim 19 is directed to a control device for controlling an image forming apparatus, and claims 20-22 depend from claim 19. The control device of claim 19 comprises a receiving unit which receives a command from a management device via a communication network, a decision unit which decides whether or not the validity of the command has expired, and a control unit which sends the command to the image forming apparatus so that the image forming apparatus performs the command when the decision unit decides that the validity of the command has not expired.

As claim 19 includes the aspects of claims 14 and 15, noted above, independent claim 19, as well as dependent claims 20-22, are patentable over the applied prior art references for the reasons noted above as to claims 14 and 15.

## **CONCLUSION**

Accordingly, it is urged that the application, as amended, is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be



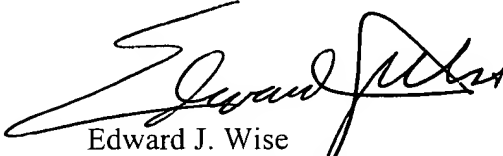
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resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicant's attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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